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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/238,950 01/27/99 BREDA

W 189334

EXAMINER

PM82/0605

LEYDIG VOIT & MAYER
TWO PRUDENTIAL PLAZA
SUITE 4900
CHICAGO IL 60601-6780

WOOD, K

ART UNIT

PAPER NUMBER

3632

DATE MAILED:

06/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/238,950

Applicant(s)

Breda et al.

Examiner

Kimberly Wood

Group Art Unit

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☒ Responsive to communication(s) filed on Mar 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) 7-13, 23-30, and 32 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6, 14-22, and 31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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This is the third office action for serial number 09/238,950, entitled Intravenous Equipment Hangers, in response to Amendment A filed on March 3, 2000 and Amendment B filed on March 20, 2000.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **openings** must be shown within the **drawings (figure 10) elected by the applicant** or the feature(s) canceled from the claim(s). No new matter should be entered.

Election/Restriction

In response to an interview with Mr. Noel Smith on April 19, 2000 the examiner has determined that claims 23-30 and 32 were drawn to a restriction requirement and not to a species election as indicated in paper no. 5. The attorney of record indicated that he would elect the claims drawn to the originally elected species Claims 1-6 and 14-22 but an indication that claims 23-30 and 32 are drawn to a restriction requirement needed to be addressed within the prosecution of the application. In regards to the arguments concerning the election of claim 6 being drawn to the elected species I the examiner has determined that claim 6 is drawn to the elected species I. Both issues discussed are addressed within this office action. In summary, the

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election requirement as elected by the applicant is therefore deemed *FINAL in regards to the election of species*.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 14-22 are, drawn to an intravenous infusion equipment hanger, classified in class 248, subclass 200.
- II. Claims 23-30 and 32, drawn to a method of supporting intravenous infusion, classified in class 29, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of using the product claimed can be practiced with hanging up hats or bags.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The inventions are distinct, each from the other because of the following reasons: During a telephone conversation with Noel Smith on April 19, 2000 a provisional election was made without traverse to prosecute the invention of I, claims 1-6, 14-22 and 31. Affirmation of this

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election must be made by applicant in replying to this Office action. Claims 7-13, 23-30 and 32 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

Claims 1-6 and 14-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim 1 clearly indicates that a subcombination is being claimed, e.g., An intravenous infusion equipment hanger for attachment to a partition. This language would lead the examiner to believe that the applicant

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intends to claim only the subcombination of "a hanger," the partition being only functionally recited. This presents no problem as long as the body of the claim also refers to the partition functionally, such as, "for attachment to said partition."

The problem arises when the partition is positively recited within the body of the claim, such as, "said flat mounting portion and from the respective partition surface...." and "in a generally vertical position parallel to and adjacent such vertical planar surface of such a partition...". There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a hanger and partition are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the hanger or the hanger in combination with the partition

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the hanger alone or the combination of the hanger and the partition. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

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Regarding claim 1, the word "means" is preceded by the word(s) "means" (in line 18) in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 14, 15, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Foley 3,048,360. Foley discloses an intravenous infusion equipment hanger assembly including a partition (14), a mounting member (22,32 &42) defining a vertical first plane (defined by 22 and 32) and including a plate 32; a detachably mounted hanger (26,30,31, and 80) having an elongate pole (26 & 80) with multiple telescopically engaged sections (26 & 80) and engagement elements 31; an offset support 24 having a flange leg 64; wherein the pole (26 &80) is spaced from said mounting member (22, 32, and 42).

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Allowable Subject Matter

Claims 16-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed March 3, 2000 and March 20, 3000 have been fully considered but they are not persuasive.

Arguments regarding the positioning of the hanger relative to the partition regarding the claims Foley clearly teaches that the hanger can be positioned vertically or horizontally relative to partition to which it is attached therefore, meeting the limitations of the positively claimed invention of the applicant.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for this Group is (703) 305-3597.


Kimberly Wood
June 5, 2000


ANITA M. KING
PATENT EXAMINER
ART UNIT 3632